

## REMARKS

This Response is submitted in reply to the Final Office Action dated May 11, 2010. Claims 54, 56 to 58, 63, 67 and 69 have been amended for clarity. Claim 70 has been cancelled without prejudice or disclaimer. Claims 1 to 53, 55, 59 and 62 were previously cancelled. A Request for Continued Examination is submitted herewith. Please charge deposit account number 02-1818 for the cost of this Request for Continued Examination and for any fees associated with this Response.

As noted above, Applicant has filed a Request for Continued Examination with this Response. Applicant requests that the Examiner allow the application or provide an upcoming Office Action which will "... identify any claims which he or she judges, as presently recited, to be allowable and/or ... suggest any way in which he or she considers that rejected claims may be amended to make them allowable" in accordance with §707.07(d) of the MPEP.

The Office Action rejected Claims 54, 56 to 58, 60, 61, 63 and 65 to 71 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,146,273 to Olsen ("Olsen '273").

As stated in the Response to Office Action dated February 3, 2010, Applicant respectfully submits that Olsen '273 does not qualify as prior art to at least Claims 54, 56, 57, 60, 61, 63 and 65 to 70 for at least the following reasons.

Under a first interpretation, the Office Action appears to interpret the last value symbol selected in the play of the bonus game illustrated in Figure 13 of Olsen '273 and described in column 8, lines 26 to 34, column 24, lines 1 to 39 and column 30, line 31 to column 31, line 27 of Olsen '273 as the end game symbols of the methods of operating a gaming machine of Claims 54, 56, 57, 60, 61, 63 and 65 to 70.

Under a second, alternative interpretation, the Office Action appears to interpret the null symbols which adjust the bonus mode length as described in column 24, lines 40 to 44 and column 30, line 31 to column 31, line 27 of Olsen '273 as the end game symbols of the methods of operating a gaming machine of Claims 54, 56, 57, 60, 61, 63 and 65 to 70.

The Office Action further interprets the bonus game illustrated in Figure 13 of Olsen '273 and described in column 24, lines 12 to 17 and column 30, line 31 to column 31, line 27 of Olsen '273 as: (i) the displayed individual numerical award values associated with the randomly generated award value symbols and (ii) the summing of the individual displayed numerical award values associated with any displayed award value symbols to form an accumulated winnings value, of the methods of operating a gaming machine of Claims 54, 56, 57, 60, 61, 63 and 65 to 70.

The effective date for Olsen '273 is the filing date of March 30, 1998. Specifically, as Olsen '273 is a continuation-in-part patent application of U.S. Patent No. 6,110,043 ("Olsen '043"). The subject matter illustrated in Figure 13 of Olsen '273 and described in column 24, lines 1 to 44 and column 30, line 31 to column 31, line 27 of Olsen '273 was not described in Olsen '043. Thus, the effective date of such subject matter from Olsen '273 is March 30, 1998.

The present patent application is a continuation patent application of U.S. Patent Application No. 10/161,498, filed on June 3, 2002, which issued as U.S. Patent No. 6,648,759, which is a continuation patent application of U.S. Patent Application No. 09/540,259, filed on March 31, 2000, which issued as U.S. Patent No. 6,398,218, which is a continuation patent application of U.S. Patent Application No. 09/346,210, filed on July 1, 1999, which issued as U.S. Patent No. 6,059,289, which is a continuation patent application of U.S. Patent Application No. 09/260,634, filed on March 2, 1999, which issued as U.S. Patent No. 6,033,307, which claims priority to Provisional Patent Application No. 60/077,042, filed on March 6, 1998 and Provisional Patent Application No. 60/077,511, filed on March 11, 1998.

Applicant submits that each and every element of at least Claims 54, 56, 57, 60, 61, 63 and 65 to 70 are supported by both Provisional Patent Application No. 60/077,042, filed on March 6, 1998 and Provisional Patent Application No. 60/077,511, filed on March 11, 1998. Thus, the effective date for at least Claims 54, 56, 57, 60, 61, 63 and 65 to 70 is March 6, 1998.

Accordingly, Applicant respectfully submits that Olsen '273 is not prior art to Claims 54, 56, 57, 60, 61, 63 and 65 to 70 and such a rejection is improper.

The Response to Arguments section of the Office Action stated:

[i]n response to the applicant's argument that Olsen is not prior art due to filing date, the examiner disagrees. The examiner points out that careful examination of application no. 081957,076 now Patent 6,110,043 which Olsen '273 is a CIP which teaches similar limitations as the presently used Olsen '273. The examiner points out that Olsen '273 cites portions of col. 8 that teaches on how bonus mode is ended if values equal or less than zero is reached, which is also found for instance in col. 4, lines 1-4 of Olsen '043. The examiner further points out that although null symbol is not explicitly mentioned in the Olsen '043 application, the main concept of achieving a zero value as a means of ending the game is addressed, taught, and supported by the Olsen '043 application with earlier filing date of Oct. 24, 1997. This therefore implies that Olsen is a good prior art and hence the rejections are maintained. Further Olsen '043 teaches in the abstract and col. 2, lines 37-38 amongst other sections, providing current values on the display such that upon the value being less than or equal to zero causes the game to end. It is also inherent to gaming machines for plurality of symbols, numbers, indices, etc to be present on the display of a gaming machine in order to assign value and determine outcomes in a gaming machine because without this symbols, there is no way for the game player to know or monitor their performance in the game.

Applicant respectfully disagrees. While both (i) column 2, lines 35 to 38 and column 8, lines 26 to 34 of Olsen '043 and (ii) column 2, lines 41 to 44 and column 4, lines 1 to 4 of Olsen '273 each relate to decrementing a pool and ending the bonus mode time period when the pool is decremented to less than or equal to zero, the remaining relied on portions of Olsen '273 are not described in Olsen '043 (i.e., were first disclosed in Olsen '273) and thus have an effective of March 30, 1998.

Specifically, as described above, the portions of Olsen '273 illustrated in Figure 13 of Olsen '273 and described in column 24, lines 1 to 39 and column 30, line 31 to column 31, line 27 of Olsen '273 are relied on to disclose: (i) the displayed individual numerical award values associated with the randomly

generated award value symbols and (ii) the summing of the individual displayed numerical award values associated with any displayed award value symbols to form an accumulated winnings value of the method of operating a gaming machine of Claim 54. However, the subject matter illustrated in this figure and these portions of Olsen '273 was not described in Olsen '043. Accordingly, the effective date of the relied on subject matter illustrated in Figure 13 of Olsen '273 and described in column 24, lines 1 to 39 and column 30, line 31 to column 31, line 27 of Olsen '273 is March 30, 1998 (which is after the effective date of March 6, 1998 for at least Claims 54, 56, 57, 60, 61, 63 and 65 to 70).

Moreover, Applicant respectfully disagrees with the statement that it is "inherent to gaming machines for plurality of symbols, numbers, indices, etc to be present on the display of a gaming machine in order to assign value and determine outcomes in a gaming machine because without this symbols, there is no way for the game player to know or monitor their performance in the game." While gaming machines include a plurality of symbols which form a plurality of symbol combinations that are associated with award values, Applicant submits that summing of the individual displayed numerical award values associated with any displayed award value symbols to form an accumulated winnings value is patentably different from a game player monitoring their performance in the game by displaying any award values associated with any formed symbol combinations. That is, it is improper for the Office Action to disregard that a reference is not prior art to certain claims and then broadly conclude that the claimed subject matter of such claims is inherent to the industry.

For at least these reasons, Applicant respectfully submits that Olsen '273 is not prior art to Claims 54, 56, 57, 60, 61, 63 and 65 to 70 and such rejection is improper.

Nonetheless, to expedite prosecution of the present application and assuming, arguendo, that Olsen '273 is prior art to Claims 54, 56, 57, 60, 61, 63 and 65 to 70, Applicant submits that Olsen '273 still does not anticipate each and every element of Claims 54, 56 to 58, 60, 61, 63 and 65 to 71.

Olsen '273 discloses a method of operating of controller-based progressive gaming system having a plurality of gaming machines wherein each gaming machine generates unit bet information indicative of a number of unit bets supplied to a machine for playing a game. The method of Olsen '273 includes randomly selecting a bonus mode activation value between a high and low limit, providing a current value, providing a base value, incrementing the current value when the gaming machines are played so that the current value is incremented by a fixed amount of each unit bet received by each gaming machine. A bonus mode time period of Olsen '273 is entered when the incremented current value is equal to or exceeds the bonus value. Eligible machines are locked-in and random bonus jackpots are made during the bonus time period. Each bonus award decrements the current value by the amount of each award and the bonus mode time period is ended when the current value is less than or equal to the base value.

The Office Action stated that:

the examiner interprets the teaching of Olsen as teaching an end game symbol when the last value symbol is selected. Because as claimed by Olsen, the game ends when the current value of the bonus game equals or drops below zero, therefore the symbol selected before this occurs can be interpreted as the end game symbol for the bonus mode.

Under a first interpretation, it appears that the Office Action is interpreting the symbol selected which causes the current value of the bonus pool to be equal to or less than zero (which ends the bonus mode time period) as the end game symbol of the method of operating a gaming machine of Claim 54. Based on this interpretation, Applicant submits that the selected symbol in Olsen '273 which causes the bonus pool to decrement to zero is unknown prior to the bonus mode time period of Olsen '273. That is, the bonus pool of Olsen '273 decrements to zero based on one or more events which occur during the bonus mode time period and which specific symbol will be selected to end the bonus mode time period is not known prior to the occurrence of these events. As described in column 24, lines 1 to 39 and column 30, line 31 to column 31, line 27 of Olsen '273 (i.e., the relied on portion of Olsen '273), the values provided to

the player during the bonus mode time period are the matched values. As which values will be matched in which order is unknown and the matched values decrement the bonus pool, the last matched value which causes the bonus pool to decrement to zero (i.e., the interpreted end game symbol) is also unknown. For example, under the Office Action's interpretation, if a first matched value of \$75 causes the bonus pool of Olsen '273 to decrement to zero, the \$75 is the interpreted end game symbol. In another example, if a second matched value of \$50 causes the bonus pool of Olsen '273 to decrement to zero, the \$50 is the interpreted end game symbol. In these examples, which value causes the bonus pool to decrement to zero is based on which matches occur and is thus unknown prior to the beginning of the bonus mode time period. In other words, Olsen '273 does not anticipate that the end game symbols are predetermined prior to any random generation of the combination of game symbols. On the other hand, the method of operating a gaming machine of amended independent Claim 54 includes that the end game symbols are predetermined prior to any random generation of the combination of game symbols.

Under a second, alternative interpretation, the Office Action appears to interpret the null symbols which adjust the bonus mode length of Olsen '273 as the end game symbols. Based on this interpretation, Applicant respectfully submits that the null symbols of Olsen '273 adjust the bonus mode length and the average number of games played in the bonus mode, but such null symbols do not end the bonus mode time period of Olsen '273. That is, such null symbols only appear to delay or prolong the bonus mode time period of Olsen '273. In other words, based on this second interpretation and unlike the method of operating a gaming machine of amended independent Claim 54, Olsen '273 does not anticipate ending play when the predetermined number of the end game symbols have been randomly generated in the generated combinations of game symbols, the predetermined number being at least one.

For at least these reasons, Applicant respectfully submits that amended independent Claim 54 is patentably distinguished over Olsen '273 and is in condition for allowance.

Claims 56 to 58, 60 and 61 depend directly from amended independent Claim 54 and are also allowable for the reasons given with respect to amended independent Claim 54 and because of the additional features recited in these claims.

Amended independent Claims 63, 67 and 69 each include certain elements similar to certain elements of amended independent Claim 54. For reasons similar to the reasoning discussed above with respect to amended independent Claim 54, independent Claims 63, 67 and 69 (and dependent Claims 65, 66, 68 and 71) are each patentably distinguished over Olsen '273 and are in condition for allowance.

The Office Action rejected Claims 64 and 72 under 35 U.S.C. §103(a) as being unpatentable over Olsen '273 in view of U.S. Patent No. 6,234,897 to Frohm et al. ("Frohm").

Applicant submits that each and every element of at least Claims 64 and 72 are supported by both Provisional Patent Application No. 60/077,042, filed on March 6, 1998 and Provisional Patent Application No. 60/077,511, filed on March 11, 1998. Thus, the effective date for at least Claims 64 and 72 is March 6, 1998. As described above, the effective date for Olsen '273 is the filing date of March 30, 1998.

Accordingly, Applicant respectfully submits that Olsen '273 is not prior art to Claims 64 and 72.

Regarding Frohm, column 1, lines 56 to 62 of the background of the invention of Frohm disclose:

[t]he bonus game is entered upon the appearance of a special symbol combination of start-bonus symbols on the reels of the slot machine in the base game. In the bonus game, the probability of winning combinations appearing on the reels, or the "hit rate," is much greater than that of the base game. The player is permitted to keep playing and accumulate winnings from the bonus game until a losing trial occurs.

Column 2, lines 13 to 24 of the summary of the invention of Frohm discloses:

[a] slot machine comprises a spinning reel display and a bonus game. The spinning reel display shows a plurality of symbols on each of a plurality of rotatable reels. The reels are rotated and stopped to place the symbols of each reel in visual association with a pay line. The pay line is associated with at least one of the symbols on each of the reels. The bonus game is triggered in response to start-bonus symbols from the respective stopped reels appearing in the spinning reel display. The bonus game having different expected values based on different arrangements of the start-bonus symbols in the spinning reel display.

As described in the Response to Office Action dated September 8, 2009 and reiterated herein, Applicant submits that, unlike the method of operating a gaming machine of Claim 64, Frohm does not anticipate or render obvious (without improper hindsight reconstruction) randomly generating a combination of a plurality of game symbols, the plurality of game symbols at least including a plurality of different award value game symbols and at least one end game symbol.

As also described in the Response to Office Action dated September 8, 2009 and reiterated herein, Applicant submits that, unlike the method of operating a gaming machine of Claim 64, Frohm does not anticipate or render obvious (without improper hindsight reconstruction) summing the individual displayed numerical award values to form an accumulated winnings value.

As further described in the Response to Office Action dated September 8, 2009 and reiterated herein, Applicant submits that, unlike the method of operating a gaming machine of Claim 64, Frohm does not anticipate or render obvious (without improper hindsight reconstruction) individual symbols that end the play of the bonus game.

Accordingly, Applicant submits that Claim 64 is patentably distinguished over Frohm and is condition for allowance.

Nonetheless, to expedite prosecution of the present application and assuming, arguendo, that Olsen '273 is prior art to Claims 64 and 72, Applicant



submits that the combination of Olsen '273 and Frohm still does not anticipate each and every element of Claims 64 and 72.

The Office Action stated:

[t]herefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Frohm et al into the teaching of Olsen. One would be motivated to do this so as to have a system whereby the award is not always the same as anticipated thereby providing a sense of anticipation to the player and hence making the game interesting for the players. One can also be motivated to include multipliers as part of the symbols so as to provide a gaming system where the outcome achieved by the players can be multiplied, thereby increasing the player interest and anticipation in the game since the player realizes that there are more chances and opportunities to attain greater payout.

Applicant respectfully submits that regardless of whether or not it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Frohm into the teaching of Olsen '273 as suggested by the Office Action, as described above, Olsen '273 does not anticipate that the at least one end game symbol is predetermined prior to any random generation of the combination of game symbols, that an individual numerical award value is associated with the randomly generated award value game symbol, and for the play of the bonus game, the individual displayed numerical award values associated with any randomly generated award value game symbols are summed to form an accumulated winnings value.

Frohm does not cure this deficiency of Olsen '273.

Accordingly, unlike the method of operating a gaming machine of Claim 64, the combination of Olsen '273 and Frohm does not anticipate or render obvious (without improper hindsight reconstruction) that the at least one end game symbol is predetermined prior to any random generation of the combination of game symbols, that an individual numerical award value is associated with the randomly generated award value game symbol, and for the play of the bonus game, the individual displayed numerical award values associated with any randomly generated award value game symbols are summed to form an accumulated winnings value.

For at least these reasons, Applicant submits that Claim 64 is patentably distinguished over Olsen '273 in view of Frohm and is condition for allowance.

Claim 72 includes certain elements similar to certain elements of Claim 64. For reasons similar to the reasoning discussed above with respect to Claim 64, Claim 72 is patentably distinguished over Frohm and also Olsen '273 in view of Frohm and is in condition for allowance.

An earnest endeavor has been made to place this application in condition for allowance and is courteously solicited. If the Examiner has any questions related to this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

K&L Gates LLP

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